

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
JOSEPH M. KOENIG, JR.)	SANDING BLOCK
)	
Serial No. 10/692,703)	Group Art Unit 3727
)	
Filed October 24, 2003)	Examiner Maurina T. Rachuba

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Briefs-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer dated March 19, 2009, Appellant provides the following remarks.

**Appellant's Request that the Case Not Be
Remanded to the Examiner for Further Clarification**

As an initial matter, although the Examiner invites a remand of the Appeal at page 8 of the Examiner's Answer, Appellant expressly requests that the Appeal not be remanded to the Examiner for further clarification. In this regard, it should be noted that Appellant has already undergone the expense of filing two Appeals and two Appeal Briefs, with the first

Appeal and Appeal Brief resulting in a withdrawal of the then pending rejection and a new grounds of rejection from the Examiner. In this case, Appellant is satisfied that the Examiner has now stated a rationale for the modification of Kingman with Hayes and does not require further clarification of this matter. It should also be noted that, contrary to the assertion by the Examiner that "it would have been preferable that Appellant had contacted the examiner on receipt of the action, so that correction could have been made," Appellant notified the Examiner of the lack of rationale for the modification of Kingman with Hayes no less than four times before Appellant's Brief on Appeal.¹ While Appellant should not have been required to undergo the expense of filing an Appeal and an Appeal Brief in order to obtain a rationale for the modification of Kingman with Hayes, it would only compound the injury to the Appellant by now remanding the case for further clarification by the Examiner. Accordingly, this Appeal should not be remanded for clarification on this issue.

**Examiner's Assertion Not Supported
by the References in the Rejection**

In response to Appellant's argument that the rejection ignores the express teachings of Kingman and proposes a modification that is contrary to these express teachings, the Examiner answers that "it is known in the art to increase the resiliency of such tools by providing an inner core that is also resilient, as taught by Meyer, which teaches a tool having a resilient core, a resilient abrasive layer, and a different shape." However, this

¹The failure to state any rationale for the modification of Kingman with Hayes was first pointed out to the Examiner in Appellant's Response of July 26, 2007, again pointed out in a response filed on January 7, 2008, again pointed out in Appellant's Response After Final filed June 6, 2008, and again pointed out in Appellant's Pre-Appeal Brief filed on September 8, 2008.

assertion is not supported by Meyer because there is nothing in Meyer that shows or suggests that its "resilient core" is provided "to increase the resiliency of such tools". Rather, Meyer discusses providing its foam backer (16) for two purposes, the first being to entrap water for its wet cleaning, and the second being to act as a cleaner when the pad is reversed. (Meyer, col. 2, lines 50-65). There is nothing in Meyer to indicate that its foam backer 16 does anything to "increase the resiliency" of the pad (10) because there is nothing in Meyer to indicate that the foam backer (16) increases the resiliency of the abrasive means (14). Nor is there anything in Meyer to indicate an advantage associated with the resiliency of its pad (10) that might be applicable in the device of Kingman, particularly the "firm scraping" engagement that produces the "efficient scraping" action desired in Kingman (Kingman, column 3, lines 45-58). Anyone who has ever utilized any tool in the cleaning of kitchen utensils will recognize instantly that a rigid core as required in Kingman produces a scraping action as required in Kingman, whereas a foam core such as taught in Meyer will not produce such an action.²

The Examiner's Reliance on *In re Fulton* is Misplaced

The Examiner also relies on *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004), but this reliance is misplaced because, unlike in the present rejection, the rejection considered in *In re Fulton* dealt with a primary reference that disclosed that

²It is important to note that Kingman requires more than just a "scouring" type action that would be provided by a pad 10 (such as in Meyer) by expressly requiring scraping and scouring engagement to produce an efficient scraping and scouring action. Again, anyone who has utilized any tool to clean kitchen utensils will understand immediately that there is a difference between "scraping" and "scouring".

alternatives could be used as proposed in the combination of the rejection, whereas in the present rejection, the primary reference Kingman expressly requires a device having "a substantially rigid body or core" as its only stated object and makes absolutely no mention of any other alternative that would be suitable to achieve its "intimate and firm scraping and scouring engagement to achieve "an efficient scraping and scouring action". (Kingman, col. 3, lines 45-56). *In re Fulton* has absolutely nothing to do with rejections wherein the primary reference suggests only one solution, let alone a rejection such as in this case wherein the primary reference expressly requires a specific solution in its only stated object of the invention, as well as in every single claim describing the invention. In this regard, it should be noted that the Examiner's Answer ignores *In re Ratti*, 270 F.2d 810 (CCPA 1959), which is relied on in MPEP §2143.01 VI and involves facts very similar to the present rejection, with a primary reference that taught a device that required rigidity for operation and a proposed combination that would substitute resiliency for the required rigidity and thereby impermissibly changed the primary of operation of the primary reference.

The Examiner's Answer Mischaracterizes the Principal of Operation of Kingman and Ignores the Only Express Object of Kingman

In the Examiner's argument extending from page 7 to page 8, the Examiner mischaracterizes the principal of operation of Kingman as being a "scrubbing or scouring action" (emphasis added), when in fact Kingman expressly describes its principal of operation as relying on its device's ability to provide "firm scraping and scouring

engagement” so as to achieve “an efficient scraping and scouring action”. The substitution of the word “scrubbing” for the word “scraping” actually used in Kingman is worth noting, because as previously argued, anyone who has attempted to clean any kitchen utensil would understand that there is a difference between scouring (or “scrubbing”) and scraping and that scraping requires a rigid core such as expressly described and required in Kingman. Furthermore, the Examiner’s Answer ignores the only expressly stated object of Kingman which is to provide a device having “a substantially rigid body or core” (Kingman, col. 1, lines 8-11). It is impermissible to modify a primary reference contrary to its express object of the invention.

**The Examiner Has No Answer for Appellant’s Arguments
Presented at the First Paragraph of Page 5 of Appellant’s Brief**

It must be noted that the Examiner’s Answer fails to acknowledge and address the arguments set forth in the first paragraph of page 5 of Appellant’s Appeal Brief stating that the benefit relied on by the Examiner in support of the proposed combination is already expressly achieved by the structure in Kingman.³ It cannot be obvious to modify a structure to provide a benefit that is already provided by the structure. In this regard, it should be noted that there is no rationale in the rejection or in the Examiner’s Answer as to why the proposed modification would provide a result other than what is already provided by the unmodified structure of Kingman.

³The present rejection asserts that “it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand tool that conforms to the shape of the workpiece.” (emphasis added)

In view of the foregoing, Appellant requests withdrawal of the rejections of claims 1-12 and allowance of the case.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By



Jeffery N. Fairchild
Reg. No. 37,825

May 19, 2009

500 West Madison Street
Suite 3800
Chicago, IL 60661-2562
(312) 876-2106